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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 755,016	01 05 2001	D. Wade Walke	LEX-0114-USA	4538

24231 7590 07 08 2003

LEXICON GENETICS INCORPORATED
8800 TECHNOLOGY FOREST PLACE
THE WOODLANDS, TX 77381-1160

EXAMINER

FRONDA, CHRISTIAN L

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 07 08/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/755,016

Applicant(s)

WALKE ET AL.

Examiner

Christian L Fronda

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED _____ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1, 2 and 5-10.10 ☐ Other _____


Continuation of 5. does NOT place the application in condition for allowance because: Claims 1, 2, and 5-10 stand rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. Claims 1, 2, and 5-10 stand rejected under 35 U.S.C. 112, first paragraph since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Applicants' arguments filed 4/4/2003 (Paper No. 7) have been fully considered but they are not persuasive for reasons of record and for the following reasons: Applicants' position is that the instant invention has patentable utility since the claimed polynucleotides can be useful polymorphic markers for forensic analysis, the claimed polynucleotides can be useful in determining the genomic structure of the protein encoding regions of the corresponding human chromosome, and the claimed polynucleotides can be used in high-throughput DNA chips. However, the listed utilities are generic utilities that are applicable to any polynucleotide.

Applicants have assigned the claimed protein as a "serine protease". Serine proteases are known in the prior art as a large family of enzymes with different biological functions and substrate specificity. However, the specification does not specifically disclose the specific biological function or the substrate specificity of the claimed protein assigned as a serine protease or polynucleotide encoding the claimed protein. Further research is required to determine the main utility of the nucleic acids and protein. Thus, the claimed protein and polynucleotide encoding has no specific and substantial asserted utility or a well established utility.

Claim 1 and 7-10 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants' arguments filed 4/4/2003 (Paper No. 7) have been fully considered but they are not persuasive for reasons of record and for the following reasons: Applicants' position is that the claimed polynucleotides meets the written description requirement since there is a structure to function relationship between the claimed fragments of SEQ ID NO: 3 and full length sequence of SEQ ID NO: 3 in that the fragments are novel and unique identifies of SEQ ID NO:3 and that the fragments can be used in PCR methods to screen libraries, isolate clones, prepare cloning and sequence templates, and assessing gene expression patterns using gene chip formats. However, the claims encompass any polynucleotide of any biological function comprising 60 contiguous nucleotides of SEQ ID NO: 3 which is not described in the specification. The specification does not provide a written description that any polynucleotide comprising 60 contiguous nucleotides of SEQ ID NO: 3 would only specifically identify SEQ ID NO: 3 since the claimed polynucleotide comprising 60 contiguous nucleotides of SEQ ID NO: 3 is not limited to only 60 contiguous nucleotides of SEQ ID NO:3 and would be expected to have additional 5' and 3' nucleotide sequences which may not be identical to any of SEQ ID NO:3. Applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise, and exact terms that a skilled artisan would recognize Applicants were in possession of the claimed invention..



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